

### **Remarks**

After entry of the present Amendment, claims 1-3, 5-20, and 22-38 are pending in the present application with claims 1 and 18 in independent form. Claims 7-9, 15, 16, 24-26, 32-33 and 35-37 are withdrawn with claims 7, 8, 24, and 25 withdrawn - currently amended. Independent claim 1 is currently amended to include the substance of dependent claim 4 and independent claim 18 is currently amended to include the substance of dependent claim 21. As such, claims 4 and 21 are currently cancelled. Claims 1, 3, 5, 6, 17, 18, 22, 23, and 29 are currently amended to address objections and rejections under §112, second paragraph. Claims 38 is currently added as a new claim. Support for new claim 38 is found throughout the application, such as in Figure 5, and no new matter is being introduced.

Figures 3, 4, 6, and 8 are objected to for various reasons addressed above in the Changes to the Drawings section and as discussed further below. The specification is also objected to as set forth further below.

Claims 1-6, 10-14, 17-23, 27-31 and 34 stand rejected under 35 U.S.C §112, second paragraph, as being indefinite. Claims 1-4, 10-13, and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,082,048 to Backes et al. (hereinafter Backes et al.). Claims 1, 4, 10-13, and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,743,047 to Bonne et al. (hereinafter Bonne et al.). Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Backes et al. in view of U.S. 6,817,651 to Carvalho et al. (hereinafter Carvalho et al.). Claims 1, 4, 10-13, and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,209,019 to Morita (hereinafter Morita) in view of U.S. Patent No. 5,269,101 to Nozaki et al. (hereinafter Nozaki et al.). Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita in view of Nozaki et al. and further in view of U.S. Patent No. 4,591,203 to Furman (hereinafter Furman). Claims 18, 21, 27, 28, 29, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita in view of Nozaki et al. Claims 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita in view of Nozaki

and further in view of U.S. Patent No. 5,557,890 to Levy et al. Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita in view of Nozaki and further in view of Furman. Claims 30 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita in view of Nozaki et al. in further view Carvalho.

### **Objection to the Drawings**

As set forth above, Figures 3, 4, 6, and 8 are currently objected to. As set forth above in the Changes to the Drawings section, Figures 3, 4, and 8 are currently amended to address the Examiner's concerns. The Applicants respectfully assert that the objection to Figure 6 is moot in light of the amendment to the specification at page 2, lines 7-8, as discussed above.

### **Objections to the Specification**

As set forth above in the Amendments to the Specification section, the specification is currently amended to address the Examiner's concerns. The Applicants respectfully assert that these amendments overcome the Examiner's objections.

### **Rejection of Claims 1-6, 10-14, 17-23, 27-31, and 34 Under §112, Second Paragraph**

Claim 1 is currently rejected under §112, second paragraph based on the use of "or" in the following section of the preamble: "A sealing, trimming, or guiding strip..." The Applicants respectfully assert that this language is not indefinite. The language merely claims that the strip can perform at least one of the functions of sealing, trimming, or guiding. The specification is consistent with claim 1 and also describes that the strip can perform at least one of the functions of sealing, trimming, or guiding. As such, the Applicants respectfully assert that the rejection of claim 1 under §112, second paragraph is improper.

Claim 1 is currently amended to delete "along" in line 4 of claim 1 to overcome the Examiner's rejection. Also, line 5 of claim 5 is currently amended to clarify the original language "part only of the length thereof," which was rejected by the Examiner.

Next, the Examiner rejects claim 1 under §112, second paragraph based on the language “at the interior side of the window pane.” The Examiner states that this language is indefinite because “it is unclear what spatial relationship the applicant is attempting to set forth.” The Applicants note that under §112, the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. This requirement does not depend on the views of an applicant or any particular individual, but rather depends on whether the scope of the claims is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. *See MPEP 2171.*

The Applicants respectfully assert that a hypothetical person possessing ordinary skill in the art would know that the “interior side” of a window pane for a vehicle is the side of the window pane that faces the interior of the vehicle and the “exterior side” of the window pane for the vehicle is the side of the window pane that faces the exterior side of the vehicle. Accordingly, the Applicants respectfully assert that “interior side” is not indefinite under §112, second paragraph.

The Examiner next rejects claim 1 under §112, second paragraph based on the language “generally oppositely facing surface.” This language is currently amended and the Applicants respectfully assert that this amendment overcomes the rejection under §112, second paragraph.

The Examiner also rejects claim 12 based on the language “so as to clamp the window pane.” The Examiner also inquires whether the “window pane” is positively recited in claim 12. The Applicants respectfully assert that in the context of claim 12 that the language “so as to” indicates functional language. In other words, the Applicants respectfully assert that the “window pane” is not positively recited in claim 12. Further, the Applicants respectfully assert that the scope of claim 12 would be understood by a hypothetical person possessing the ordinary level of skill in the pertinent art. As such, the Applicants respectfully assert that the rejection of dependent claim 12 under §112, second paragraph is improper.

Finally, each of the typographical errors indicated by the Examiner in claims 1, 3, 4, 6,

17, and 18 are addressed by amendments to those claims. As such, the Applicants respectfully assert that these rejections under §112, second paragraph, are overcome.

### **Rejection of Dependent Claim 1 Under §102 over Backes**

The Applicants respectfully assert that amended independent claim 1 is novel over Backes et al. because Backes et al. fails to teach each and every element of amended independent claim 1. Specifically, the Applicants respectfully assert that Backes et al. fails to teach “a portion of the extruded material along only a part of the length of the extruded material having been removed and replaced with molded material,” as claimed in amended independent claim 1. First, Backes et al. makes absolutely no mention of “extruded material having been removed and replaced with molded material.” In contrast, Backes et al. merely discloses an extruded material 11 and moulded material 10 that are adhered together. Further, the moulded material 10 is not added to the extruded material 11 “along only a part of the length of the extruded material,” as claimed in independent claim 1. In contrast, as set forth in column 2, lines 9-15, the moulded material 10 of Backes et al. forms the whole of the strip 5 surrounding the opening 8 and, as shown in Figures 2 and 3, the moulded material 10 is adhered to the extruded material 11 along the strip surrounding the opening 6. As such, the Applicants respectfully assert that Backes et al. fails to teach “a portion of the extruded material along only a part of the length of the extruded material having been removed and replaced with molded material,” as claimed in amended claim 1.

Consequently, the Applicants also respectfully assert that Backes et al. fails to teach “the channel remaining as part of the strip after removal of said portion of the extruded material” (emphasis added) and “this extended extruded material also remaining as part of the strip after removal of said portion of the extruded material,” (emphasis added) as claimed in amended independent claim 1. Since, Backes et al. fails to teach “extruded material having been removed and replaced with molded material,” the Applicants respectfully assert that Backes et al. cannot teach a channel and extended extruded material “remaining as part

of the strip after removal of said portion of the extruded material, as claimed in claim 1. Said differently, since there is no “removal,” Backes et al. cannot teach anything remaining “after removal.” For these reasons, the Applicants respectfully assert that the rejection of independent claim 1 as being anticipated by Backes et al. is improper.

### **Rejection of Independent Claim 1 Under §102 over Bonne**

The Applicants respectfully assert that amended independent claim 1 is novel over Bonne et al. because Bonne et al. fails to teach each and every element of amended independent claim 1. Specifically, the Applicants respectfully assert that Bonne et al. fails to teach “a portion of the extruded material along only a part of the length of the extruded material having been removed and replaced with molded material,” as claimed in amended independent claim 1. First, the Examiner interprets Bonne et al. such that the hard rubber web 26 is “molded material;” however, the Applicants respectfully assert that the hard rubber web 26 of Bonne et al. is not molded but is instead extruded. Specifically, in the paragraph beginning at column 3, line 15, Bonne et al. discloses that “[E]xtruded on the outer edge of arm 6...is the inner part of the window guide section 3. This window guide section consists of s hard rubber web 26.” In other words, the hard rubber web 26 is extruded and, as such, cannot be properly interpreted as “molded material” of claim 1.

Further, Bonne et al. makes absolutely no mention of “extruded material having been removed and replaced with molded material.” The Examiner references column 1, lines 55-58 of Bonne et al. as teaching this element; however, the Applicants respectfully assert that this section of Bonne et al. makes no mention of any feature that could be interpreted as “extruded material having been removed and replaced with molded material.” The Applicants respectfully request clarification of the Examiner’s interpretation of column 1, lines 55-58 of Bonne et al. In any event, the Applicants respectfully assert that Bonne et al. makes no such teaching.

Consequently, the Applicants also respectfully assert that Bonne et al. fails to teach

“the channel remaining as part of the strip after removal of said portion of the extruded material” (emphasis added) and “this extended extruded material also remaining as part of the strip after removal of said portion of the extruded material,” (emphasis added) as claimed in amended independent claim 1. In other words, since there is no “removal,” Bonne et al. cannot teach anything remaining “after removal.” For these reasons, the Applicants respectfully assert that the rejection of independent claim 1 as being anticipated by Bonne et al. is improper.

### **Rejection of Independent Claims 1 and 18 Under §103**

The Applicants respectfully assert that independent claims 1 and 18, as currently amended, are nonobvious over the combination of Morita and Nozaki et al. Specifically, the Applicants respectfully assert that a person having ordinary skill in the art would not have led to modify the seal structure 1 of Morita such that the molded material includes “at least one integral formation for securing the molded material to the window frame,” as claimed in amended independent claims 1 and 18.

First, the Applicants respectfully assert that the combination of Morita and Nozaki et al. fail to teach, or even suggest, all of the claim limitations of amended independent claims 1 and 18, which is required to properly prove a *prima facie* case of obviousness. The Examiner states on page 10 of the present Office Action that Morita teaches “an integral formation 126 for securing the molded material to the window frame.” (emphasis added). The Applicants respectfully disagree and assert that the door frame holding portion 126 of Morita is instead formed of extruded material. In fact, Morita discloses in column 3, lines 34-36 that “elements 11, 12, and 13 are formed of an elastic material such as rubber and a plastic material by integral extrusion.” Further, Nozaki et al. fails to teach, or even suggest, molded material that includes “an integral formation for securing the molded material to the window frame,” as claimed in amended independent claims 1 and 18. As such, the Applicants respectfully assert that the combination of Morita and Nozaki fail to teach, or

even suggest, a strip “in which the molded material includes at least one integral formation for securing the molded material to the window frame,” as claimed in amended independent claims 1 and 18. Accordingly, the Applicants respectfully assert that the Examiner failed to prove a *prima facie* case of obviousness of independent claims 1 and 18.

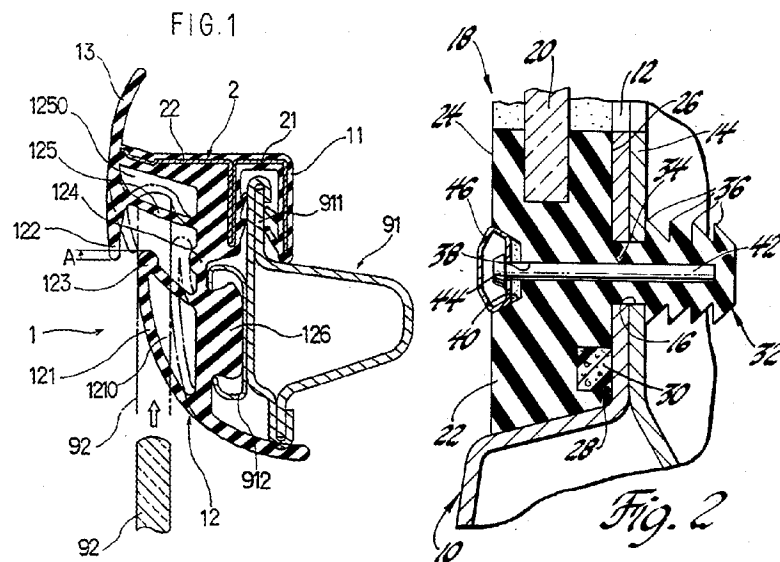
In any event, the Applicants respectfully assert that it would not have been obvious to modify Morita such that “the molded material includes at least one integral formation for securing the molded material to the window frame.” With reference to Figure 1 of Morita, a person having ordinary skill in the art would have absolutely no reason to remove the extruded door frame holding portion 126 and subsequently mold another door frame holding portion 126 in its place. Such a step would be unnecessary because the seal structure of Morita already has the door frame holding portion 126 when extruded and, thus, the frame holding portion 126 does not need to be removed merely to be replaced by another frame holding portion. As such, a person having ordinary skill in the art would not have modified Morita in such a way. Accordingly, the Applicants respectfully assert that amended claim 1 is nonobvious over the combination of Morita and Nozaki et al.

Further, since Morita is silent about replacing extruded material with molded material, Morita makes no teaching as to which parts of the extruded material remain after removal of the part of the extruded material. Said differently, Morita makes no teaching as to location of the cut line where the part of the extruded material is removed. Nozaki et al. also fails to provide such a teaching. Claims 1 and 18 specifically claim that the channel remains as part of the strip after removal of the portion of extruded material. Claims 1 and 18 also claim that the second window pane receiving surface and the generally oppositely facing surface remain as part of the strip after removal of the portion of extruded material. Neither Morita nor Nozaki et al, alone or in combination, make such a teaching. For this reason, the Applicants respectfully assert that independent claims 1 and 18 are nonobvious over Morita and Nozaki et al.

Aside from the nonobviousness of independent claims 1 and 18, the Applicants respectfully assert that dependent claim 5 and 22, which are dependent from claims 1 and 18,

respectively, claim additional nonobvious features. The Examiner states that Morita and Nozaki et al. fail to teach or suggest “wherein at least one of the integral formations comprises an aperture in the molded material through which a clamping member passes,” as claimed in dependent claims 5 and 18; however, the Examiner states that Furman teaches such a feature and it would have been obvious to modify Morita, as already modified by Nozaki et al., to include this feature of Furman. The Applicants respectfully disagree and assert that such a modification would improperly render the seal structure 1 of Morita unsatisfactory for its intended purpose of sealing to the window glass 92.

For reference purposes, Figure 1 of Morita is presented on the left below and Figure 2 of Furman is presented on the right below:



With reference to these figures, such a modification of the frame holding portion 126 of Morita would compromise the seal intended to be created between the window glass 92 and the sliding seal portion 121, thereby rendering the seal unsatisfactory for its intended purpose of sealing to the window glass 92. Specifically, such a modification would require a hole to be formed not only through the frame holding portion 126 but also through the sliding seal portion 121 such that the pin 42 of Furman can be placed into this new hole. Such a hole through the sliding



seal portion 121 would clearly compromise the seal between the sliding seal portion 121 and the window glass 92, thereby rendering the seal structure 1 unsatisfactory for its intended purpose. Since the proposed modification would render the seal of Morita unsatisfactory for its intended purpose, the Applicants respectfully assert that dependent claims 5 and 22 are nonobvious over the combination of Morita and Nozaki et al. and Furman.

### **New Dependent Claim**

Aside from the novelty and nonobviousness of independent claim 1, the Applicants respectfully assert that new dependent claim 38 claims additional features that are novel and nonobvious over the prior art. Specifically, the Applicants respectfully assert that both Backes et al. and Bonne et al. fail to teach or suggest an oppositely facing surface on the interior side of the window pane with the window pane disposed between the second window pane receiving surface and the oppositely facing surface, as claimed in new claim 38. In contrast, as shown in Figure 3 of Backes et al., the extruded material 56 extends only along one side of the window glass 76, i.e., the window glass 76 is not disposed between a second window pane receiving surface and an oppositely facing surface as claimed in new claim 38. As shown in Figure 1 of Bonne et al., the hard rubber web 26, which the Examiner interprets as the “extruded material” of claim 1, extends only along one side of the window pane 12. For these reasons, the Applicants respectfully assert that new dependent claim 38 is novel over both Backes et al. and Bonne et al.

In view of the foregoing, it is respectfully submitted that independent claims 1 and 18, and the claims that depend therefrom, are both novel and nonobvious such that these claims are in condition for allowance, which allowance is respectfully requested. If any issue regarding the allowability of any of the pending claims could be readily resolved, or if other action could be taken to further advance prosecution, such as an Examiner’s Amendment, it is respectfully requested that he Examiner telephone the undersigned in this regard.

Although no additional fees are believed to be due, the Commissioner is authorized to charge our Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment for this matter.

Respectfully submitted,

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